

5/15/02

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 8
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Library Association

Serial No. 76/082,254

Lisa Parker Gates of Jenner & Block, LLC for American Library Association.

Bridgett Smith, Trademark Examining Attorney, Law Office 115 (Thomas Vlcek, Managing Attorney).

Before **Cissel**, **Walters** and Holtzman, Administrative Trademark Judges.

Opinion by **Cissel**, Administrative Trademark Judge:

On July 3, 2000, applicant filed the above-referenced application to register the mark shown below



on the Principal Register for a "series of fiction and nonfiction books on a variety of topics," in Class 42. The application was based on applicant's claim of use of this mark in commerce on these goods since January of 1994.

The Examining Attorney refused registration under Section 2(d) the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that the mark applicant seeks to register so resembles the mark "ALA," which is registered¹ for "educational services-namely, providing instruction by classes, residential school programs and the like, to others for development of English language skills and cultural background, and the training of teachers and development of multi-media materials for such instruction," in Class 41, that confusion is likely. Registration was also refused based on the registration of a second mark, a highly stylized presentation of the same letters for the same services, owned by the same entity.

The Examining Attorney reasoned that confusion is likely because the dominant portion of the mark applicant seeks to register is the same arbitrary letter combination as in the cited registered marks, and the goods set forth in the application are closely related to the services

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¹ Reg. No. 1,286,516 issued on the Principal Register to the American Language Academy, Inc. on July 17 1984; affidavits under Sections 8 and 15 of the Act were received and accepted.

recited in the two registrations. Submitted in support of the refusal to register were copies of three third-party registrations wherein the goods and services included both books and educational services.

In addition to refusing registration, the Examining Attorney required applicant to disclaim the descriptive word "Editions" apart from the mark as shown, and to correctly classify the goods specified in the application.

Applicant responded by disclaiming the descriptive word "Editions" and amending the application to properly state that applicant's goods are in Class 16. Applicant argued that the refusal to register was not well taken because its mark is distinguishable from the cited registered marks and its goods are distinguishable from the services recited in the cited registrations.

The Examining Attorney accepted the amendments, but was not persuaded by applicant's arguments with respect to the issue of likelihood confusion. The refusal to register under Section 2(d) the Act was continued and made final in the second Office Action. Submitted with that Action as additional support for the refusal were copies of six more third-party registrations wherein use with both books and educational services was claimed.

Applicant timely filed a Notice of Appeal, followed by its appeal brief. The Examining Attorney filed her brief in response to applicant's brief. In her brief, she withdrew the second cited registration (wherein the mark is a highly stylized design) as a bar to registration of applicant's mark, but maintained the refusal based on the registration of the mark "ALA" in typed form. Applicant did not file a reply brief or request an oral hearing before the Board.

Accordingly, we have resolved this appeal based on the written record in this application, the arguments presented by applicant and Examining Attorney in their briefs and the relevant legal authority.

The predecessor to our primary reviewing Court listed the principal factors to be considered in determining whether confusion is likely in the case of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the relationship between the goods and services.

Turning first to the marks, we note that in determining whether confusion is likely, we must consider the marks in their entirety, but that under appropriate

circumstances, one portion of a mark may play a more dominant role in creating the commercial impression of the mark as a whole. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Applying this principle to the facts of the instant case, we conclude that the dominant portion of applicant's mark is the letters "ALA," and that the descriptive, and hence disclaimed, word "Editions" plays a less significant role in the creation of the commercial impression of this mark, as does the brush-stroke design which appears beneath the letters and the word. Literal portions of marks combining both designs and words are typically dominant because consumers call for the goods or services in the marketplace by those portions. In *re Appitito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). In the same sense, arbitrary combinations of letters are dominant when combined with descriptive terminology, which does not function as an indication of source.

Accordingly, we find that the dominant element in the mark applicant seeks to register is the three-letter combination "ALA," which is identical to the cited registered mark.

Our inquiry thus turns to consideration of the relationship between the goods specified in the application and the services recited in the registration. The goods

and services need not be identical or directly competitive in order to find that confusion is likely. They need only be related in some manner or the conditions surrounding their marketing must be such that they are likely to be encountered by the same purchasers under circumstances that are likely to give rise to the mistaken belief that the goods and services are provided by a single source. In *Re Martin's Famous Pastry Shoppe, Inc.*, 478 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In *re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). A key point in this regard is that we must consider the goods only as they are specified in the application and registration, respectively, without limitations or restrictions that are not reflected therein. *Toys "R" Us, Inc. v. Lamps R Us*, 219 USPQ 340 (TTAB 1983).

The third-party registrations made of record by the Examining Attorney demonstrate that other entities have registered their respective marks for both books and educational services. This evidence leads us to conclude that consumers who are presented with both books and educational services under the same or similar marks are likely to assume that they emanate from a single source. See: *Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Co.*, 6 USPQ2d 1467 (TTAB 1988). It is

consistent with both common sense and experience to expect a business which provides a training course to also provide the printed materials used in the training.

Applicant argues that the particular books with which it uses its mark are completely unrelated to the particular training courses rendered under the cited registered mark, that the channels of trade differ, and that the purchasers of applicant's books are sophisticated, and as such, would not be easily confused. Neither the application nor the cited registration, however, is limited or restricted as to channels of trade or class of purchasers, and there is no evidence that prospective purchasers of a "series of fiction and nonfiction books on a variety of topics" are any different from or more sophisticated than the people who take registrant's classes to develop their English language skills and cultural background, or the teachers who are trained by registrant to teach such classes.

Applicant argues that it is not aware of any instances of actual confusion between its mark and the cited mark, but evidence of actual confusion is not necessary in order to establish that confusion is likely. In re Kangaroos U.S.A., 223 USPQ 1025 (TTAB 1984). Applicant's argument that it owns a family of marks using the letters "ALA" is similarly unpersuasive. Not only is it unsupported by any

evidence, it is irrelevant. In this appeal, we are limited to deciding whether confusion is likely between applicant's mark in the cited registered mark. The issue of whether applicant uses other marks which are also likely to cause confusion with the registered mark is not before us.

In summary, confusion is likely in the case at hand because the dominant portion of the mark applicant seeks to register is the same arbitrary three-letter combination that is the whole mark in the cited registration, and because the record shows that books and educational services are closely related. We are left with no doubt as to this conclusion, but even if we did have doubts, they would necessarily be resolved against applicant and in favor of the prior user and registrant. *Medtronic Devices, Inc. v. Medical Devices, Inc.*, 204 USPQ 317 (TTAB 1979).

DECISION: The refusal to register under Section 2(d) the Lanham Act is affirmed.